

Supreme Court of the United States

October Term, 1949.

No. 19

19

TODD C. FAULKNER,

Petitioner

vs.

JOHN T. GRAS,

Respondent

PETITION OF TODD C. FAULKNER FOR
HEARING AND FOR STAY OF MANDATE

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IN THE
Supreme Court of the United States

October Term, 1949

No. 49

TODD C. FAULKNER,

Petitioner,

JOHN T. GIBBS,

v. S.

Respondent.

**PETITION OF TODD C. FAULKNER FOR RE-
HEARING AND FOR STAY OF MANDATE**

Comes now the above-named Petitioner, Todd C. Faulkner, and presents this, his Petition for a Rehearing of the above-entitled cause and for a Stay of the Mandate of this Court until final disposition of the case, and in support thereof respectfully shows:

This Court by a *per curiam* decision dated November 7, 1949, affirmed the judgment below, stating that the case of *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1 (1946), was "inapposite." The Court then said:

"In the instant case, the patent *has been sustained because of the fact of combination*, rather than the novelty of any particular element (Emphasis added.)"

But how can this "fact of combination" distinguish the instant case from the *Halliburton* case, when the claims involved in the *Halliburton* case were also sustained by the lower courts on the ground of combination, rather than the novelty of any particular element?

The claims in this case and those in the *Halliburton* case are substantially identical in form. Both are combinations of admittedly old elements. Both define all of the essential elements in terms of "means."

In what respect then is the *Halliburton* case inapposite?

The Decisions of the Ninth Circuit Court of Appeals in the *Halliburton* Case.

In the first decision of the Ninth Circuit Court of Appeals in the case of *Halliburton Oil Well-Cementing Co. v. Walker*, 146 F. 2d 817, the Court, in speaking of the apparatus of the claims in suit stated:

"The apparatus or system claimed is old, as indeed are all of the other elements of his combination."
(Emphasis added.)

With respect to the merit of the invention in the *Halliburton* case, the Court said:

"Walker made a very substantial improvement over Lehr and Wyatt, notwithstanding it is conceded that both his recorder and his amplifier, considered by themselves are old in the art. * * * He has combined features which achieve a new result or at least an old result in a better way. * * *

"We think too that Walker specified and claimed his improvements with sufficient distinctness and clarity to comply with the statute." (Emphasis added.)

In denying Halliburton's Petition for a Rehearing, in *Halliburton Oil Well Cementing Co. v. Walker et al.*, 149 F. 2d 896, the Court in response to defendant's contention that the claims in suit were bad for functionality under the doctrine of *General Electric v. Wabash*, 304 U. S. 364, 37 U. S. P. Q. 466 and *Davis Sewing Machine Co. v. New Departure Mfg. Co.*, 217 Fed. 775, sought to distinguish the *General Electric* case by stating:

"Here, (in the Halliburton case) the claims are for a combination of elements." (Emphasis added.)

Judge Denman filed a separate opinion concurring in the denial of a rehearing in the *Halliburton* case in which he stated:

"Appellant's principal contention on its Petition for Rehearing concerns the patenting of a combination of functional means such as claimed in typical claims 1 and 14 cited in the opinion. * * *

"Since the combination of all such means has novelty and usefulness, I agree in the denial of the Petition for Rehearing." (Emphasis added.)

It is abundantly clear that the Ninth Circuit Court of Appeals sustained the claims in the *Halliburton* case, "because of the fact of combination rather than the novelty of any particular element."

In the *Halliburton* case, this Court reversed the concurrent holdings below and decided as a matter of law that the claims there in suit were functional and void under R. S. 4888, in spite of the fact that they were for a combination.

But in the instant case this Court has refused to disturb the concurrent findings below because the claims are for a combination.

It is respectfully submitted that the confusion alleged by Respondent to have resulted from the *Halliburton* decision will be compounded many times over, unless the Court's views on the issues involved herein are clarified.

Comparison of the Claims in the *Halliburton* Case With Those in the Instant Case.

To more clearly show the identity in form of the claims in the *Halliburton* case and the instant case, we here reproduce Walker's claim 1st in suit in the *Halliburton* case and Gibbs' claim 3 in suit in this case. To facilitate comparison, we adopt the outline of the Walker claim as set forth in Judge Denman's concurring opinion denying *Halliburton's* Petition for Rehearing (149 F. 2d 896) and an outline of Gibbs' claim 3 substantially as set forth on page 7 of our Opening Brief.

Walker Claim 1

(A) "In an apparatus for determining the location of an obstruction in a well having therein a string of assembled tubing sections interconnected with each other by coupling collars.

(B) *means* communicating with said well for creating a pressure impulse in said well.

Gibbs Claim 3

(A) "A game apparatus comprising a board having a plurality of contact devices thereon adapted to be engaged by an object moved over the board by a player, a plurality of indicators.

(B) *means* for electrically connecting said indicators with a source of electric current and with said contact devices, said indicators

and said contact devices corresponding in number and arrangement and subdivided into corresponding groups,

(C) *echo-receiving means* including a pressure responsive device exposed to said well for receiving pressure impulses from the well and for measuring the lapse of time between the creation of the impulse and the arrival at said receiving means of the echo from said obstruction,

(C) *means* for energizing said indicators as the associated contact devices are operated,

(D) an electric circuit common to all of said groups and open until all of the indicators in one of said groups have been energized,

(D) and *means* associated with said pressure responsive device for tuning said receiving means to the frequency of echoes from the tubing collars of said tubing sections to clearly distinguish the echoes from said couplings from each other."

(E) and *supplementary means* for indicating a winning play when all of the indicators in one of said groups have been energized."

In the Halliburton case, all of the elements going to make up the claimed combination were admittedly old in the art. *In the instant case*, all of the elements going to make up the claimed combination are likewise admittedly old in the art.

In the Halliburton case, the combination of Walker's claim 1 included *three* separate elements defined in terms of "means," to-wit: "means communicating," "echo-receiving means," and "means for tuning." *In the instant case*, the combination of Gibbs' claim 3 includes *three* separate elements defined in terms of "means," to-wit: "means for connecting," "means for energizing," and "means for indicating."

In the Halliburton case, the Ninth Circuit Court of Appeals held Walker's claim 1 valid because it was a combination of element (all old). *In the instant case*, the Ninth Circuit Court of Appeals held Gibbs' claim 3, also made up of old elements, to be valid for the same reason.

In the Halliburton case, this Court in spite of the concurrent findings below held as a matter of law that the combination claims there in suit were invalid for functionality under R. S. 4888.

In the instant case, this Court has taken the position that the findings are not "clearly erroneous," and consequently that the claims in suit are valid *because they are for a combination*.

In the Halliburton case, all but one of the elements of each of the claims in suit were shown in the prior Lehr

and Wyatt patent No. 2,047,974. This remaining element, lettered D, in Judge Denman's opinion and in our outline, *supra*, was described in functional language as "means associated with said pressure responsive device for tuning said receiving means to the frequency of echoes from the tubing collars of said tubing sections to clearly distinguish the echoes from said couplings from each other."

This Court held, in line with its prior decisions, that the use of functional language to describe the sole element not shown in the prior Lehr and Wyatt patent rendered the claim bad for functionality.

In the instant case, all but one of the elements of the Gibbs claims in suit present in Petitioner's game are also shown in a single prior art patent, to-wit: Nakashima, No. 1,678,573. The remaining element lettered C in our outline, *supra*, is described in purely functional language as

"means for energizing said indicators as the associated contact devices are operated,"

It is apparent therefore that Gibbs' claim 3 in suit uses functional language to describe the sole element not shown in the prior Nakashima patent, to-wit: the relays R and their armatures R' used by Gibbs to energize his indicator lamps.

The other claims here in suit likewise use functional language to describe the sole element therein not shown by the Nakashima patent. In the interest of brevity we

have not outlined them here. They are outlined and discussed at length in our briefs on file.

With such a clear parallel between the claims in the instant case and the *Halliburton* case, we are unable to understand the Court's position herein.

The *Halliburton* decision held claims for a combination of old elements *bad* for functionality. This case holds claims which are on all-fours with the claims in the *Halliburton* case, *good* because they are for a combination of elements, admittedly old.

It is submitted that these decisions are inconsistent and will cause endless argument and divergent opinions both in and out of the Courts until they are reconciled.

The principal question raised in the petition for certiorari herein, and applicable to all of the claims in suit, was as follows:

Question 1—Is the doctrine of *Halliburton Oil Well Cementing Co. v. Walker, et al.*, 329 U. S. 1, 67 S. C. 6, 71 USPQ 175, condemning the use of indefinite and functional language at the exact point of novelty in patent claims for a combination of mechanical and acoustical elements, applicable to claims for a combination of mechanical and electrical elements where the only feature of novelty in the claims is described broadly in terms of "means," or is said decision to be ignored as was done by the Court of Appeals in this case?

A secondary question, applicable only to claims 9 and 10 in suit, was also raised:

Question 2—Where a court holds an accused apparatus not to infringe certain patent claims because said apparatus does not include an essential element of said claims, is it not contrary to fundamental law and logic for the court in the same decision to hold other claims of said patent which specify the *same essential element*, infringed by the said accused apparatus?

These questions are firmly grounded in the facts of this case and arise as a result of the decisions below. Certiorari was granted to consider them. Neither has been decided.

Petitioner sincerely believes that it will be to the best interest of all concerned for a rehearing to be granted in this case to give the Court an opportunity to clarify its position on the issues involved, so that the lower Courts, the Patent Office and the patent profession can know what the law of this Court is as respects functionality in combination claims.

Additionally, it is thought that since this case originated in the Ninth Circuit, and since Mr. Justice Douglas, who was unable to participate in the decision due to his unfortunate accident, will now be able to participate in the consideration of the case, and since the decision was *per curiam*, a reconsideration of the issues herein is both timely and appropriate.

The issues are important, and the supersedeas bond on file is adequate, and consequently it is believed that the mandate should be stayed pending the final outcome of the case.

For the foregoing reasons, it is respectfully urged that this Petition for Rehearing and the Stay of Mandate be granted, and that the judgment of the United States Court of Appeals for the Ninth Circuit be, upon further consideration reversed.

Respectfully submitted,

ROBERT W. FULWIDER,

Attorney for Petitioner.

JAMES P. BURNS,

Of Counsel.

I, Robert W. Fulwider, Attorney for the above-named Petitioner, do hereby certify that the foregoing Petition for Rehearing and Stay of Mandate in this cause is presented in good faith and not for delay.

ROBERT W. FULWIDER.

November 18, 1949.